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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09-919,919	08-02-2001	Jim Smit	P66237US0	3988

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JACOBSON HOLMAN PLLC
400 SEVENTH STREET N.W.
SUITE 600
WASHINGTON, DC 20004

EXAMINER

DEL SOLE, JOSEPH S

ART UNIT	PAPER NUMBER
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1722

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DATE MAILED: 02/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/919,919

Applicant(s)

SMIT ET AL.

Examiner

Joseph S. Del Sole

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-12 is/are allowed.
- 6) ☐ Claim(s) 13 and 16 is/are rejected.
- 7) ☐ Claim(s) 14-15 and 17-20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 1/25/02 is being considered by the examiner. However the Applicants' admission of testing more than one year prior to the filing date of the instant application raises questions concerning possible public use or sale of the invention more than one year prior. With regard to section 2133.03(b) of the MPEP, was the invention sold more than 1 year before the effective filing date of the U.S. application?

With regard to 2133.03(e)(1), was there any attempt at market penetration/ commercial exploitation before the critical date? The Applicant's state that the plug was tested on commercial underwater pelletizing line. Were pellets produced during this testing, and more than one year before filing, that were sold? This would indicate that there was commercial exploitation and public use of the plug. MPEP 2133.03(a)A1 states that "'Nor... is all secret use ipso fact not public use within the meaning of the statute,' if the inventor is making commercial use of the invention under circumstances which preserves its secrecy".

Additionally, the Applicants' indicate that the insulation plug was tested "in order to test the invention and demonstrate its efficacy over the prior art insulation in the commercial production of polymer pellets." With regard to section 2133.03(e)(3), had the invention been reduced to practice, and therefore experimental use having ended, more than one year prior to filing? At what date did specific modifications or refinements of the invention, if any, end? Any modifications or refinements which did

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result from such experimental activity must at least be a feature of the claimed invention.

Section 2133.03(e)(4) lists factors indicative of experimental purpose. The Examiner requests that the Applicants provide greater detail of the nature of their testing. The Applicants should refer to the above factors in addressing this. The Examiner also suggests a review by the Applicants of MPEP section 2133.03(e)(6) that discusses permitted experimental activity and testing.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 13 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Dudley (4,123,207).

Dudley teaches an underwater pelletizer (Fig 3) having an extrusion die (Fig 3, #400) in the form of a die plate having a die face (Fig 3) provided with a central circular recess (Fig 3, at #815A) and orifices around its periphery through which molten polymer is extruded from the die face, a cutter hub (Fig 3, #806) supporting a plurality of cutter knives (Fig 3, #812) which cooperate with the die face to cut polymer strands extruded through the orifices into pellets, and a water box (Fig 3) surrounding the cutter hub, cutter knives and die face to cool the extruded polymer and transport the polymer pellets away from the die face, and a rigid circular insulation plug (Fig 3, #813) inserted

in the die face central recess in close fitting relationship thereto to reduce; the rigid circular insulation plug is a solid one piece construction made of a material having low heat conductivity (Fig 3, #813 and col 4, lines 20-27).

4. Claims 13 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Harris et al (5,593,702).

Harris et al teach an underwater pelletizer (Fig 3) having an extrusion die (Fig 3, #37) in the form of a die plate having a die face (Fig 3, #45) provided with a central circular recess (Fig 3, #35) and orifices around its periphery through which molten polymer is extruded from the die face, a cutter hub (Fig 3, #55) supporting a plurality of cutter knives (Fig 3, #57) which cooperate with the die face to cut polymer strands extruded through the orifices into pellets, and a water box (Fig 3) surrounding the cutter hub, cutter knives and die face to cool the extruded polymer and transport the polymer pellets away from the die face, and a rigid circular insulation plug (Fig 3, #33 and the plate there attached by screws) inserted in the die face central recess in close fitting relationship thereto to reduce; the rigid circular insulation plug is a solid one piece construction made of a material having low heat conductivity (Fig 3).

5. Claims 13 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Applicant's admission at page 2, line 13 - page 3, line 4 and reference 'AS' of the IDS.

Applicant's admission teaches an underwater pelletizer having an extrusion die in the form of a die plate having a die face provided with a central circular recess and orifices around its periphery through which molten polymer is extruded from the die face, a cutter hub supporting a plurality of cutter knives which cooperate with the die

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face to cut polymer strands extruded through the orifices into pellets, and a water box surrounding the cutter hub, cutter knives and die face to cool the extruded polymer and transport the polymer pellets away from the die face, and a rigid circular insulation plug inserted in the die face central recess in close fitting relationship thereto to reduce; the rigid circular insulation plug is a solid one piece construction made of a material having low heat conductivity.

Allowable Subject Matter

6. Claims 1-12 are conditionally allowed over the prior art of record, but greater detail must be given concerning the testing of the invention one year prior to filing.

7. Claims 14-15 and 17-20 are objected to as being dependent upon a rejected base claim, but would be conditionally allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Greater detail must be given concerning the testing of the invention one year prior to filing.

8. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record fails to teach or suggest an insulation plug including a rigid plate inserted into the recess of a die face and having a raised portion to form an air gap with the recess.

References of Interest

9. Ma et al (5,611,983) and Matsuo (5,989,009) are cited of interest to show the state of the art.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph S. Del Sole whose telephone number is (703)

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308-6295. The examiner can normally be reached on Monday through Friday from 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wanda Walker, can be reached at (703) 308-0457. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for non-after finals and (703) 872-9311 for after finals.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Wanda Walker
J.S.D.
January 22, 2003

Robert Davis
ROBERT DAVIS
PRIMARY EXAMINER
GROUP 1300/1722

1/23/03